F. The Questions Presented are Substantial.

(1) Patent Misuse: Extension of the Monopoly.

Our patent laws are designed to promote the progress of science and useful arts by encouraging inventors to make their inventions known rather than to keep them secret. The contract between the inventor and the public is a monopoly for seventeen years, in return for the dedication to the public of the know-how and a full description of the manner of carrying out and using the invention. 35 U.S.C. 112; Coffin v. Ogden, 18 Wall. (85 U.S.) 120; Application of Schlittler, 234 F.2d 882 (C.C.P.A. 1956). On the date of the issuance of the patent, the patentee acquires the exclusive right to make, use and sell his invention, in accordance with the details described in the specification. 35 U.S.C. 154.

Question 1 in this case involves patent misuse as defined by this Court. Any legal device employed by the inventor, or anyone claiming under him, to secure, to any extent, an extension of his monopoly, is a patent misuse and runs counter to the policy of our patent laws. The doctrine is founded on reasons of public policy. Scott Paper Co. v. Marcalus Mfg. Co., 326 U.S. 249, 256; Mercoid Corp. v. Mid-Continent Invest. Co., 320 U.S. 661, 665; Ethyl Gasoline Corporation v. United States, 309 U.S. 436; Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225, 229; Brulotte v. Thys, 379 U.S. 29.

Appellant has urged that if U.S.P. 3,079,397 and U.S.P. 3,166,475 which cover the identical subject matter of U.S.P. 2,878,263, are assigned to Johnson & Johnson, the effect will be an unconstitutional extension of the seventeen-year monopoly. The New Jersey Supreme Court disposes of the issue

with the holding that "the patent claim in [U.S.P. 2,878,263] was carefully limited to the compound itself and did not extend to the process and use." (Appendix B at 7a). Appellant submits that this holding is replete with errors and invalidates 35 U.S.C. 101, 112 and 154. A claim must be read in the light of the specification, a copy of which is annexed and made part of the Letters Patent. 35 U.S.C. 154.

By the express statutory language, 35 U.S.C. 154, the patent claim on the compound itself in U.S.P. 2,878,263, gave Johnson & Johnson the right of making, using and selling the compound, by reference to the specification for the details. Obviously Johnson & Johnson in 1959 acquired the right to make the substance, by the novel process and for the use described in the specification. In this case, the novel process for making the product and the novel use of the substance, are integral with the invention for the product. The substance cannot be made except by the process described in the specification and has no other utility except as described therein. (Appendix C, at 21a.) The invention, stripped of the technicalities of the language of the claims, resides in the making of a novel substance, 4-methyl 4-phenyl 5-pyrazolone, which shows novel non-obvious utility to treat convulsions.

In James v. Campbell, 104 U.S. 356, 377, 382, this Court said:

> "Where a new process produces a new substance, the invention of the process is the same as the invention of the substance . . . It is hardly necessary to remark that the patentee could not include in a subsequent patent any invention embraced or described in a prior one."

In Miller v. Eagle Manufacturing Co., 151 U.S. 186, 198, a distinction was made between the same patentee and another party:

> "...no patent can issue for an invention actually covered by a former patent especially to the same patentee, although the term of the claims may differ..." (Emphasis added.)

Accord, Mosler Safe Co. v. Mosler, 127 U.S. 354, 361. One Court has paraphrased the same rule by stating that a patentee may not extract an essential element from his own prior patent, without which the former patent would not have been granted, and make it the subject of a subsequent patent. Palmer Pneumatic Tire Co. v. Lozier, 90 Fed. 732 (6th Cir. 1898). It would amount to "double patenting."

In determining whether a second patent is distinct from the earlier one, courts do not consider merely a one-line claim, but whether the specifications are substantially different and whether the claims of the later patent find support in the earlier patent. Miller v. Eagle Manufacturing Co., supra, at 202. U.S.P. 2,878,263, involved in this appeal, would not have issued, without a full description of the process and use of the product. Further, the two later patents, in appellant's name, U.S.P. 3,079,397 and U.S.P. 3,166,475, add nothing to the state of the art. The claims find complete support in the specification of the earlier patent. The only exception to the seventeen-year monopoly, for the same invention, is permitted where there is a conflict of interest, in the case of an interference, as in this instant case, and the subsequent patent is awarded to the real inventor, a party other than the first patentee. 35 U.S.C. 135. The United States Patent Office would not have issued the two later patents to Johnson & Johnson.

There may be instances in which product, process and use are separable. Manual of Patent Examining Procedure, U.S. Department of Commerce (1961) Sec. 806.05(f) (Appendix D). This Court stated the applicable law in Powder Co. v. Powder Works, 98 U.S. 126, 137. Here, however, the New Jersey Supreme Court has drawn a non-existing separation between product, process and use, in spite of the fact that in 1960, the United States Patent Office had found that they constituted part of a single invention.

Johnson & Johnson has enjoyed a full monopoly since 1959, with the broad product claim of U.S.P. 2,878,263. Assignment of the two later patents, which issued in 1963 and 1965 respectively, will result in unconstitutionally rewarding the employer with an extension of the monopoly for an additional six-year period.

The New Jersey Supreme Court operates on the erroneous assumption that breadth of monopoly depends on the number of claims, and states:

> "Ortho was under no obligation to broaden its claims beyond its claim to the compound itself." (Appendix B, 5a)

This holding is clearly erroneous. The crux of the matter is that 35 U.S.C. 112 permits to define a single invention with "one or more claims," which may fall into more than one of the statutory classes of product, process and use. Manual of Patent Examining Procedure, U.S. Department of Commerce, Sec. 706.03(k) (Appendix D). No relationship exists between the number of claims and the breadth of the monopoly. The reverse is generally true. A single claim, as in this case, gives the broadest possible monopoly. Additional claims are frequently included

to narrow the scope of the monopoly, in the event the broadest claim, later, is found to be anticipated. Ellis, Patent Claims, Baker, Voorhis & Co. (1949) at 141, 588.

Contrary to the holding of the New Jersey Supreme Court, a product claim, as respondents obtained in 1959, is the broadest and most comprehensive. In General Electric Co. v. Wabash Appliance Corp., 304 U.S. 364, 373, 374, this Court noted that a product claim seeks to monopolize the product, no matter how created. A product claim gives the patentee a monopoly to every process which may be subsequently discovered for the manufacture of the product, and to every use of which the product is susceptible, "whether such use be known or unknown." Roberts v. Ryer, 91 U.S. 150, 157; Plummer v. Sargent, 120 U.S. 442, 448; Application of Ruschig, 343 F.2d 965, 979 (C.C.P.A. 1965). In General Electric Co. v. DeForest Radio Co., 17 F.2d 90, 98 (D.C. D. Del. 1927), the Court said:

> "There are two well established and well known modes of claiming a product of a process. One is to claim the product only as produced by the particular process. Another is to claim the product broadly, irrespective of the method of production." (Emphasis added.)

A process or use claim may be worthless in an infringement action. Ellis, loc. cit., at 450, 459. In Merrill v. Yeomans, 94 U.S. 568, this Court dismissed an infringement proceeding because the patent only claimed the process and did not include product claims. The patentee had failed to include claims on the product, which would have sustained the cause of action.

Johnson & Johnson chose the broad product claim with full awareness that it gave them the most comprehensive monopoly. In the language of their patent counsel:

> "...if you can get a claim in your patent to the product, you have an absolute monopoly on that product for a period of seventeen years, regardless of the process that might be used to prepare the compound." (Respondents' Appendix at 53a.)

Manifestly the conclusion of the New Jersey Supreme Court that substitution or addition of a process or method claim would have "enlarged" the monopoly, is contrary to logic, judicial decision, and to respondents' plain admissions.*

In a society where most scientists are employees of large corporations, subject to compulsory contracts, the decision of the Supreme Court of New Jersey jeopardizes our entire patent system. Unless the holding below is reversed, an employer will be encouraged to deliberately obtain patents in the name of one who is not the inventor, and after asserting

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* The cases cited by the New Jersey Supreme Court are totally inapplicable (Appendix B, 6a et seq.). They deal with dedication to the public of subject matter described in the specification and not expressly claimed. The fundamental difference is that in this appeal, product, process and use are integral parts of a single invention. In the cited cases, on the other hand, a *non-essential* element had been described in the specification and not expressly claimed. For example, in *Brown v. Guild*, 90 U.S. 181, 185, the patentee had secured five reissue patents for each of his two earlier patents. The Court held that the non-essential element, described and not claimed, in the ten reissue patents, had been donated to the public. Similarly, *Motion Picture Patents Co. v. Universal Film Co.*, 243 U.S. 502, dealt with a patented machine and a notice restriction by the patentee that it should be used only with certain films which were not part of the invention. *Mahn v. Harwood*, 112 U.S. 354, dealt with the validity of a reissue, where the patentee sought enlargement of the monopoly, long after the issuance of the first patent, to the detriment of the public.

a monopoly for several years, will urge invalidity of its patents, at its convenience, for any technicality, including its own refusal to narrow the scope of the claims, and simultaneously will compel assignment of patents subsequently issued in the name of the real inventor. The net effect will be extension of the monopoly with benefit accruing to the employer, and a fraud on the public. This unconstitutional result is unavoidable, where no penalty is imposed, and on the other hand, the employer is rewarded with ownership of the subsequently issued patents.

(2) A Patent Must Issue in the Name of the Real Inventor.

Question 2 in this appeal involves the fundamental right of inventorship and intellectual credit guaranteed by U.S. Const., Art. I, Sec. 8, Clause 8. A patent must issue in the name of the real inventor. 35 U.S.C. 111; 37 C.F.R. 1.41 (Appendix D.)

This Court has condemned practices of fraud on the United States Patent Office. Obtaining a patent in the name of one who is not the inventor, is such gross fraud that the patent is null and void. Kennedy v. Hazelton, 128 U.S. 667. In Precision Co. v. Automotive Co., 324 U.S. 806, 816, this Court said:

> "The far reaching social and economic consequences of a patent...give the public a paramount interest in seeing that patent monopolies spring from backgrounds free from fraud or other inequitable conduct and that such monopolies are kept within their legitimate scope."

The fraud on the public, on the United States Patent Office and, of course, appellant, permeates this entire

proceeding. Even assuming for the sake of argument, respondent Oroshnik conceived the idea of making the compound, as the New Jersey Supreme Court would seem to infer, he could not be the inventor. Under our laws, an invention comprises: 1) conception of idea 2) reduction to practice and 3) utility. These requirements are set forth in U.S. Const., Art. I, Sec. 8, Clause 8, 35 U.S.C. 101 and 112. In re Bremner, 182 F.2d 216 (C.C.P.A. 1950). In Manson v. Brenner, 333 F.2d 234 (C.C.P.A. 1964) cert. granted, 33 U.S.L. Week 3349, now pending before this Court, the requirement of utility of a product is not disputed. Particularly in the case of chemical inventions, the inventor is the one who reduces the idea to practice and discovers the utility of the compound. Bourne v. Jones, 114 F. Supp. 413, 418 (S.D. Fla. 1952).

Respondents admit the lack of two of the three essentials to constitute inventorship of the product, namely the process necessary to make the substance and the finding of the novel use. Thus, when Oroshnik executed the oath that he was the inventor, at the time he applied for a patent, in colorable compliance with 35 U.S.C. 115, he knowingly executed a false oath. Further, Johnson & Johnson's taking advantage of their patentee status and refusal to continue the interference proceeding because they knew they would lose in that tribunal, constitutes deliberate defiance of federal law. The discharge of the plaintiff, under the malicious accusation of "incompetency," three days after the substance proved of outstanding value as an anticonvulsant, is another instance of fraud.

The trial judge, after deciding on the matter of proprietary rights in favor of the employer, concluded, as a matter of law, that a scientist has no right of intellectual credit for his or her invention:

> "The Court: ... Such examination of the law as I have made, indicates to me that there is no right for a person, who has no property rights in an invention, to insist upon his or her name being mentioned." (R199a-22 and Original Transcript at 785.)

This monstrous and unconstitutional holding was reversed by the Appellate Division. That court held, that the right of inventorship is guaranteed both by federal law and common law principles. It properly held that credit for an invention is not alienable (Appendix C, 16a to 18a) and that an invention comprises not only conception of idea but reduction to practice and a showing of utility (Appendix C, 19a).

The Appellate Division, also, found that no conclusion may be drawn from the general jury verdict of no cause of action, because of the errors of law and the trial judge's belief that appellant was merely "annoying the respondents" and that she had no cause of action (Appendix C at 41a, 31a). The Appellate Division, found prejudicial error in the charge to the jury with respect to the entire subject matter of U.S.P. 2,878,263, not merely the one-line claim (Appendix C, 19a to 29a). It said:

> "Defendants have made no serious refutation of the proposition that if plaintiff did legally invent the compound and the process for making it, she possessed a professional right of intellectual credit... The patent issued in the name of Oroshnik as inventor, although claiming

only the compound, also published the process and the idea of treating convulsions with the compound, thereby imputing all to his inventorship . . . (at 16a).

> "The use of the product for treatment of convulsions was plainly stated in the patent and the representation of Oroshnik as inventor fairly extended to that feature of the disclosure as well as to the compound itself and the process. Defendants clearly recognized this aspect of the issues, as they were at pains to have their expert McLean testify that adding a use description to the claim would not validate it." (Emphasis added.)

The serious errors of law in the charge to the jury led the Appellate Division to reversal. The issue of deprivation of intellectual credit for everything described in the specification, was so recognized at trial, that the respondents "were at pains" to prove that plaintiff's claim of credit was groundless and valueless (Appendix C, 27a).*

Throughout trial and in their briefs before both the Appellate Division and the Supreme Court of New Jersey, respondents have continued to deprecate the invention, while simultaneously retaining the monopoly on the public (Appendix C at 28a). Now the Supreme Court of New Jersey, in reversing the Appellate Division, in favor of Johnson & Johnson, summarily concludes that the serious errors of law in the charge

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* Respondents produced an expert to testify that use claims could not be obtained, and that the process of making the compound was not patentable. The Appellate Division, however, reversing, found that, contrary to the respondents' position, claims on a novel use may be obtained, and that their reliance on a repealed statute and an old 1943 decision, cannot be the law today. (Appendix C, 20a).

to the jury, are "not material" (Appendix B, 6a). This conclusion is reached in spite of the fact that respondents recognized the issues at trial and "were at pains" to prove that the entire invention, product, process and use, was worthless. The incredible conclusion is reached merely because two patents have issued, some two and three years after trial, in appellant's name, and because appellant has not proven special damages. In direct contrast, the Appellate Division had found that the mere issuance of the later patents, would not relieve respondents of liability and that proof of special damages was not essential (Appendix C, 32a).

The facts are essentially undisputed. Appellant had conducted extensive research in the same field of the invention involved in this appeal. A patent, U.S.P. 2,776,289 (Exh. P-7, R273a) in her sole name, unequivocally demonstrates her expertise in the same field, prior to her employment with Johnson & Johnson. The Appellate Division has so described the circumstances surrounding the invention and the relationship with appellant's prior field of research (Appendix C, at 11a):

> "...She began to use her spare time at Ortho on a problem which had long defied organic chemists although considerable work had been done on it. The making of a substance which would contain the beneficial qualities of barbiturates but not their undesirable toxic and habituating characteristics. It is her contention that she succeeded at Ortho in doing so and that the patent which issued to Ortho by the United States Patent Office on March 17, 1959 in the name of William Oroshnik as inventor (No. 2,878,263), claiming the compound, "4-methyl 4-phenyl 5-pyrazolone" resulted from her discovery of that compound."

The Appellate Division also found that appellant on January 26, 1956, at one of the company seminars, has disclosed her idea of making the product. The written exhibit corroborated her testimony (Appendix C, 12a). In April 1956, after several unsuccessful experiments, she succeeded in making the substance. Pharmacological testing established the value as an anticonvulsant. Three days later, on April 25, 1956, she was summarily discharged.

There is evidence that the legal staff of Johnson & Johnson prepared the patent application on the novel anticonvulsant at the very time of the discharge. They, however, kept it concealed, delayed and did not file the patent application in the United States Patent Office, until two years later. The reason for the delay is that at the time of the discharge, April 1956, Johnson & Johnson wished to conceal appellant's scientific contributions. The concealment went as far as denying under oath the existence of patent applications covering appellant's invention. (Affidavit of November 21, 1960; Testimony of April 12, 1961.)

The attorneys for Johnson & Johnson have admitted they knew that the plaintiff would claim to be the inventor, but concealed the filing of the patent application from her because of the litigation:

> "We did not consult her about it, because at that time, Dr. Misani had been discharged from employment and we were involved in litigation with her." (March 23, 1962 Transcript at 19.)

Although the facts surrounding the delay in filing and concealment of the invention, for malicious motives, are undisputed, the New Jersey courts have held that an employer has the absolute right to con-

ceal employees' inventions, "throw them out of the window" (R66a) and "scrap them at its unfettered will" and later seek patent rights. Appellant submits that this holding nullifies our constitutional policy of promoting the progress of science and useful arts, U.S. Const., Art I, Sec. 8, Clause 8 and 35 U.S.C. 102(c). In Woodbridge v. United States, 263 U.S. 50, this Court so construed R.S. 4886, the predecessor of 35 U.S.C. 102(c):

> "Any practice by which the inventor deliberately and without excuse postpones beyond the date of the actual invention, the beginning of the term of the monopoly and puts off the free public enjoyment of the useful invention is an evasion of the statute."

Johnson & Johnson's patent staff has admitted having copied from appellant's research records, in her handwriting, the subject matter of U.S.P. 2,878,263, which is in the name of Oroshnik. On the crucial question of decision as to inventorship, the patent staff of Johnson & Johnson has no explanation, except that Oroshnik told them that he had "conceived the idea" (Appendix C, 38a). It is this oral self-serving declaration on the part of Oroshnik, with no proof whatsoever, neither from other witnesses, nor any written documents, which, according to the New Jersey Supreme Court, relieves Johnson & Johnson from liability (Appendix B, 5a).

The express refusal of the New Jersey courts to apply federal law, in a field of federal pre-emption, is manifest from the denial of appellant's motion for judgment on the issue of inventorship (Appendix C, at 33a). Appellant has urged application of rule of the United States Patent Office, 37 C.F.R. 1.216(a)(4) (Appendix D) which makes the testimony of a

party, as to his conception of idea, inadmissible, unless corroborated by authentic exhibits or some witnesses. Respondent Oroshnik's testimony as to his alleged conception of idea of making the compound, was totally uncorroborated, and, of course, inadmissible. Application of federal law would have entitled appellant to her motion for judgment. U.S. Const., Art VI; Sperry v. Florida, 373 U.S. 379.

The rule is substantive, designed to prevent perjury and analogous to the two-witness requirement in the law of treason. Cramer v. United States, 325 U.S. 1. Conception of idea is an act of the mind and must be corroborated by extrinsic evidence. Otherwise each party could fabricate dates and facts to suit his convenience. Radio Corporation of America v. Philco Corporation, 201 F. Supp. 135, 149 (E.D. Pa. 1961); Townsend v. Smith, 36 F.2d 292, 295 (C.C.P.A. 1929); 2 Walker, Patents, (Secs. 201, 206, Deller's Ed. 1937).

The trial judge expressly disregarded federal law ("I am not interested in the rules." R130a to R131a), permitted Oroshnik to testify as to his alleged conception of idea and denied appellant's request of a special verdict and submitting written interrogatories to the jury. One of the denied interrogatories was:

> "Who conceived the idea?" (R213a)

The Appellate Division found error in the denial. It said:

> "The foregoing discussion, incidentally, points up the desirability in such a case as this of requesting a special verdict from the

> jury on the issue of the identity of the inventor." Plaintiff made such a request below (Appendix C, at 31a).

In spite of the finding by the Appellate Division, the Supreme Court of New Jersey draws an inference in favor of respondent Oroshnik, from the general jury verdict of no cause of action. This conclusion is not only unwarranted, but an express arrogation of the authority given to Congress by the Constitution. If this holding is not reversed, an employer will be permitted and encouraged to evade federal law, defeat an adjudication of inventorship by the United States Patent Office, and win a contest according to employer-made rules.

(3) A Patentee Who Has Not Disclaimed His Own Patent Nor Corrected the Errors, May Not Argue in Derogation of His Own Grant.

According to the New Jersey courts, an employer may refuse to disclaim a patent, 35 U.S.C. 253, refuse to limit the scope of the monopoly, 35 U.S.C. 251, continue to assert the broad monopoly upon the public, and later may argue invalidity of its own patent, to defeat the employee's cause of action (Appendix C, 15a; Appendix B, 5a). This holding effectively destroys our constitutional policy, invalidates 35 U.S.C. 251 and 253 and must be reversed.

Johnson & Johnson's defiance of federal law is manifest from their language:

> "We could [disclaim], but that is solely within our privilege to do so or not to do so, we are the owners of the patent" (R163a).

Johnson & Johnson had the duty to disclaim the patent or limit the broad scope of the product claim, as early as January 1961, when the United States Patent Office notified the parties that the interference proceeding, based on the product claim, would be dissolved. Ensten v. Simon, Ascher & Co., 282 U.S. 445, Altoona Theatres v. Tri-Ergon Corp., 294 U.S. 477, 490. Appellant has urged that a party who continues to enjoy the benefits under a patent, is not permitted to argue invalidity, to defeat the adversary's cause of action. Kinsman v. Parkhurst, 18 How. (59 U.S.) 289, 293; United States v. Harvey Steel Co., 196 U.S. 310, 316; Sola Electric Co. v. Jefferson Co., 317 U.S. 173, 175. Appellant's argument, however, has been rejected.

Contrary to the unsupported conclusion of the New Jersey Supreme Court, appellant never conceded that U.S.P. 2,878,263 is invalid as to subject matter.* The Appellate Division properly passed upon "the narrow question of the validity of the patent claim and remedying the defects" (Appendix C, 29a, 18a).

In flagrant disregard of federal law, the trial judge charged the jury that appellant had no cause of action because U.S.P. 2,878,263 was "invalid, legally invalid," and that Johnson & Johnson had no duty to correct the error:

> "They own it...that is their business, that is not her business" (R66a; R55a to R57a).

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* Appellant repeatedly said:
"The subject matter of the patent is perfectly good...The patent is valid, although the claim is defective." (R75a-1-24; R75a-23-5).

Also the Supreme Court of New Jersey has accepted Johnson & Johnson's assertion of invalidity, not accompanied by a disclaimer.

(4) The Refusal to Permit Appellant to Adduce Evidence as to the Constitutionality of the Contract, Violates Due Process of Law.

1. One of the issues in this appeal is the comprehensive compulsory contract, an agreement to assign inventions to the employer, enforced against appellant in this second case. The blanket refusal to permit appellant to introduce evidence in support of her contention that the contract as enforced is unconstitutional, amounts to a denial of due process of law (R125a; R237a).

In order to justify the refusal to permit evidence of unconstitutional application, the New Jersey courts summarily apply the doctrine of res judicata as if the issues had been disposed of in the first case (Appendix B, 4a). The crux of the matter, however, is that the doctrine of res judicata has been applied in vacuo, because the same contract was not even mentioned in the courts' opinions in the first case. Further, appellant has sought and respondents have opposed at every stage* consolidation of the two cases. Thus, the doctrine of res judicata rewards Johnson & Johnson for splitting the litigation and taking conflicting positions at different stages.

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* As late as her Petition for Certiorari, Docket No. 819, Fall Term, 1962, appellant requested this Court to postpone consideration of her Petition until the second case was decided by the New Jersey courts.

The contract in issue is shown at page 8 of the Petition for Certiorari, Docket No. 819, Fall Term, 1962, in the first case. It was executed on February 28, 1955, two months after beginning of employment. The contract is of the "adhesion type," and shows the evils of a society where the employer imposes on a research scientist the contract of its liking, with prospective application ad infinitum. The contract is not limited to specific work assigned, but strips the employee of all inventions and ideas, present, past and to a great extent, even future inventions and ideas, after termination of employment. Included in the contract are Ortho Pharmaceutical, Johnson & Johnson and the family of some eighty subsidiaries, including the foreign subsidiaries.

As presently enforced by the New Jersey courts, the employer gives nothing to the employee, employment "at will," "for five minutes" (R125a; Court's opinion, attached to Petition for Certification in the first case, at 82a). The employee, however, is bound to assign to anyone of the Johnson & Johnson subsidiaries, her inventions, improvements, ideas and patents, with no limitation in time.

The two patents in issue are the result of appellant's legal training after the discharge by Johnson & Johnson. Unable to find employment in her field, appellant has completed Law School, passed Bar Examinations, and is registered to practice before the United States Patent Office. Appellant has prepared and prosecuted herself the two patent applications which issued as U.S.P. 3,079,397 and U.S.P. 3,166,475.

The consideration by the employer in the written contract was left in the ambiguous term: "In view of my employment and wages and salary paid." On February 28, 1955, appellant was induced to sign

under the representation that the employment could not be terminated except for good and just cause, after notice and hearing. In the first case, however, the trial judge dismissed the contract count on the ground that the contract of employment was terminable "at will," at any time, for no reason.

He found that there was no cause for the discharge, no foundation for the charge of incompetency, that the plaintiff had not been given a hearing, but concluded that the contract was terminable at will and she had no right to a hearing. (Court's opinion in the first case at 50a, 53a, 67a, 75a.) In reaching the conclusion of employment "at will," the judge did not consider the written contract in issue here, and ignored the promises made at the time the contract was executed. Manifestly the cause of action for breach of the employment contract would have been sustained, if the promises made at the time the contract was executed, had been considered.

The crux of our patent policy is the incentive to the individual inventor. The rationalization for the granting of a monopoly rests upon the assumption that rewarding the individual inventor for limited times serves the public interest and protects and encourages initiative, talent and inventive ability. The monstrous holding of the New Jersey courts that an individual must assign all her inventions, before and after employment, to the employer, in return for nothing from the employer, expressly destroys our constitutional policy.

2. On the matter of rights of an employer to the inventions of an employee, with and without a contract of assignment of inventions, the New Jersey courts are in striking conflict with the decisions of this Court. Normally, the employee retains title of his inventions,

and the employer gets, at the most, a shopright. A contract to assign must be supported by adequate consideration flowing from the employer to the employee. At no time an employee who has been discharged for no reason, "at will," has been compelled to assign his inventions to the employer, after termination of employment. The contract has come to an end. Hapgood v. Hewitt, 119 U.S. 226; U.S. v. Dubilier Condenser Corp., 289 U.S. 178; Standard Parts Co. v. Peck, 264 U.S. 52.

3. The New Jersey courts are also in conflict with the holdings from other jurisdictions as well as prior holdings of the New Jersey courts. Kinkade v. N.Y. Shipbuilding Corp., 21 N.J. 362 (1956); Texas Co. v. Gulf Refining Co., 26 F.2d 394 (5th Cir. 1928); Cahill v. Regan, 5 N.Y. 2nd 292, 297, 157 N.E. 2nd 505, 508 (Ct. App. N.Y. 1959); Triumph Electric Co. v. Thullen, 228 Fed. 762 (E.D. Pa. 1916); Simmons v. California Institute of Technology, 194 P.2d 521 (Sup. Ct. Cal. 1948); aff'd 34 Cal. 2nd 264, 209 P.2d 581 (1949).

4. The splitting of the litigation and application of the doctrine of res judicata in the second case, have operated as a denial of due process of law as to all the issues involved, in this nine-year litigation. In the first case, appellant urged fraud at the hiring, namely that she was hired presumably to conduct research work in Medicinal Chemistry, with no limitation as to a specific project, but with the undisclosed motive of exploiting her prior expertise in a very limited field, and then discharging her. The trial judge, however, in the first case, refused to consider the connection in subject matter between U.S.P. 2,878,263 and appellant's specialized prior knowledge. Similarly, the malicious accusation of "incompetency" in the first case, became, in this second case, that

appellant of course "was a scientist who could use her head and knowledge," as good as any other senior chemist (R62a; Appendix B, 4a). The destruction of a scientist's professional status has never been considered by the New Jersey courts, nor submitted to a jury.

Conclusion

Plenary review of the issues involved in this appeal is respectfully urged. All the questions are of profound importance in a society where the individual scientist is subject to compulsory "adhesion-type" contracts, and where the employer may, under the shield of state law, enlarge the scope of the patent monopoly.

The conflict between the printed opinions of the Appellate Division and the Supreme Court of New Jersey, by itself, merits consideration. If appellant has chosen the improper route for seeking review, the Court is respectfully urged to grant certiorari.

Respectfully submitted,

FERNANDA MISANI
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Westfield, New Jersey

APPENDIX A

JUDGMENT

This cause having been duly argued before this Court by Mrs. Fernanda Misani (Fiordalisi), counsel for appellant and Mr. Clyde A. Szuch and Mr. Stanley C. Smoyer, counsel for the respondent, and the Court having considered the same,

It is hereupon ordered and adjudged that the judgment of the said Superior Court, Appellate Division is affirmed in part and reversed in part; and it is further *ordered that this mandate shall* issue ten days hereafter, unless an application for rehearing shall have been granted or is pending, or unless otherwise ordered by this Court, and that the record be remitted to the Superior Court, Appellate Division to be there proceeded with in accordance with the rules and practice relating to that court, consistent with the opinion of this Court.

WITNESS the Honorable Joseph Weintraub, Chief Justice, at Trenton on the first day of June, 1965.

s/ John H. Gildea
Clerk of the Supreme Court

FILED
June 1, 1965
John H. Gildea
Clerk

A TRUE COPY
s/ John H. Gildea,
Clerk

PETITION FOR REHEARING

No Justice who voted with the majority having moved a reconsideration the petition for rehearing is denied.

Witness, the Honorable Joseph Weintraub, Chief Justice, at Trenton, this first day of July, 1965.

s/ John H. Gildea
Clerk

FILED
July 1, 1965
John H. Gildea
Clerk

APPENDIX B

Opinion of the Supreme Court of New Jersey

PER CURIAM. The trial court dismissed the plaintiff's action as against some of the defendants and the jury returned a general verdict in favor of the remaining defendants. On appeal, the Appellate Division ordered a new trial as to the defendants Ortho, Oroshnik and Johnson & Johnson. See 83 *N. J. Super.* 1 (1964). Thereafter, we granted cross-petitions for certification. 43 *N. J.* 264 (1964).

[1, 2] The plaintiff was employed by Ortho in January 1955 after she had responded to an advertisement seeking an organic chemist to perform "research in synthetic medicinal chemistry" of "basic character." Shortly thereafter she signed an agreement which assigned to Ortho all of her rights in inventions, improvements and ideas which she might make or conceive during her employment. The Appellate Division held that this was a valid and binding agreement and that under its terms Ortho owned outright any inventions made or conceived by the plaintiff while in its employ and was free to use or discard them "or to patent them or scrap them, wholly or partly, at its unfettered will." 83 *N. J. Super.*, at *pp.* 12–13. We agree with this holding. See *Patent & Licensing Corp. v. Olsen*, 188 *F. 2d* 522, 525 (2 *Cir.* 1951); *Paley v. Du Pont Rayon Co.*, 71 *F. 2d* 856, 858 (7 *Cir.* 1934); *Goodyear Tire & Rubber Co. v. Miller*, 22 *F. 2d* 353, 355 (9 *Cir.* 1927); see also *Universal Winding Co. v. Clarke*, 108 *F. Supp.* 329 (*D. Conn.* 1952); *Restatement (Second), Agency* § 397, comment a (1958).

[3] The plaintiff continued as an employee of Ortho until April 25, 1956 on which date her employment was terminated. In 1957 she instituted an action at law against Ortho and others claiming that her employment was terminable only for cause, economic necessity or general incapacity and asserting charges of various nature. After a trial before Judge Barger sitting without a jury, her action was dismissed. On appeal, the dismissal was sustained by the Appellate Division in an opinion which has not been published in the reports and we denied certification. 38 *N. J.* 304 (1962). Although the plaintiff has sought to reassert her claim that her employment was wrongfully terminated, the Appellate Division in the present proceeding properly held that she was barred from doing so. See 83 *N. J. Super.*, at *p.* 13. Under settled principles of *res judicata*, all of the matters which were decided adversely to her by Judge Barger are now foreclosed to her. See *Washington Tp.* v. *Gould*, 39 *N. J.* 527, 533 (1963); *New Jersey Highway Authority* v. *Renner*, 18 *N. J.* 485, 493 (1955).

[4] In 1959 Ortho obtained patent No. 2,878,263 on compound 4-methyl-4-phenyl-5-pyrazolone. This patent named William Oroshnik as inventor and assignor to Ortho. Oroshnik was the plaintiff's supervisor while she was in Ortho's employ. He testified that he had conceived the idea for the pyrazolone compound and had directed the plaintiff to make it; he acknowledged that she had worked out the details of the process but that this was what he would expect of any senior chemist functioning under his direction and possessing basic chemical know-how. See 83 *N. J. Super.*, at *p.* 11. The plaintiff testified that the idea was hers and she contends that, notwithstanding her transfer of ownership to Ortho, she was entitled to be named as inventor and may assert a tort claim grounded on the naming of Oroshnik rather than her. During the trial, the plaintiff conceded that the patent issued on the compound *per se* was invalid (83 *N. J. Super.*, at *p.* 17); she acknowledged that the patent on the compound had been anticipated by the *Beilstein* reference (83

N. J. Super., at *p.* 16) and contended, however, that if Ortho had broadened its application so as to include claims to the process in making the compound and to the use of the compound, it could have obtained a valid patent. But Ortho was under no obligation to broaden its claims beyond its claim to the compound itself and it unequivocally asserts before us, as it did before the lower courts, that patent No. 2,878,263 on the compound itself is invalid. Although the plaintiff now seeks before us to withdraw the concession below on the basis of which the trial was conducted, and to advance the contention that the patent on the compound *per se* is not invalid, we consider that she is in no just position to do so. See *State v. Atlantic City Electric Co.*, 23 *N. J.* 259, 264 (1957); *Gebhardt v. Public Service Coord. Transport*, 48 *N. J. Super.* 173, 182 (*App. Div.* 1957), certif. denied 25 *N. J.* 540 (1958). See also *Journeymen Barbers, etc., Local 687 v. Pollino*, 22 *N. J.* 389, 395 (1956); *Beckmann v. Township of Teaneck*, 6 *N. J.* 530, 537 (1951).

In 1963 the plaintiff herself obtained patent No. 3,079,397 on the process and in 1965 she obtained patent No. 3,166,475 on the use or "method for relieving convulsions." During the trial she introduced no substantial testimony to indicate that she had suffered any special damage from the omission of her name and the inclusion of Oroshnik's name in patent No. 2,878,263. *Cf. Prosser, Torts* § 122 (*3d ed.* 1964); 1 *Harper & James, Torts* §§ 6.1, 6.4 (1956). And in the light of the whole record including the trial court's charge, we believe that the jury's verdict may fairly be read as evidencing its finding that there had been no lack of good faith in connection with the application for the patent and that, as between the plaintiff and Oroshnik, the latter rather than the former conceived the idea for the compound. Notwithstanding the afore-mentioned considerations pointing against her asserted claim for damages, the Appellate Division concluded that the plaintiff was entitled to a new trial. In reaching this conclusion, it expressed the view that the representation in the patent of Oroshnik as inventor is to be taken as extending to

the process and use as well as to the compound itself (83 *N. J. Super.*, at *p.* 24); we are satisfied that that view was erroneous and that the ensuing grant of a new trial to the plaintiff was equally erroneous.

[5, 6] While the Appellate Division soundly found on the record before it that the plaintiff could not sustain any claim for damages insofar as inventorship credit for the compound itself was concerned (83 *N. J. Super.*, at *p.* 17), it proceeded to set aside the jury's verdict on the finding that there had been erroneous instruction concerning patentability of the process as distinct from the compound (83 *N. J. Super.*, at *pp.* 20–22) and erroneous failure to instruct concerning patentability of a novel use of the compound (83 *N. J. Super.*, at *pp.* 24–25). But those matters were not material and caused no prejudice in the case at hand unless there was actually an actionable misrepresentation that Oroshnik rather than the plaintiff was the inventor insofar as process and use were concerned. The Appellate Division in effect made such a finding when it stated that although the patent issued to Ortho in the name of Oroshnik as inventor admittedly claimed only the compound, it also published "the process and the idea of treating convulsions with the compound, thereby imputing all to his inventorship." 83 *N. J. Super.*, at *p.* 14; see also 83 *N. J. Super.*, at *p.* 24. Nothing in the record before us affirmatively supports any such imputation and the infringement cases, while not controlling here, contain much judicial language to indicate that no representation of inventorship may fairly be said to attach to matters of process and use set forth in the specification but not in the patent claim itself. See 35 *U. S. C. A.* § 112 (1954); *Brown v. Guild*, 23 *Wall.* 181, 224–225, 90 *U. S.* 181, 224–225, 23 *L. Ed.* 161, 170 (1874); *Mahn v. Harwood*, 112 *U. S.* 354, 360–361, 5 *S. Ct.* 174, 28 *L. Ed.* 665, 668 (1884); *Motion Picture Patents Co. v. Universal Film Mfg. Co.*, 243 *U. S.* 502, 510, 37 *S. Ct.* 416, 61 *L. Ed.* 871, 876 (1917); *General Electric Co. v. Wabash Appliance Corp.*, 304 *U. S.* 364, 368–369, 52 *S. Ct.* 899, 82 *L. Ed.* 1402, 1405 (1938); *Graver*

Tank & Mfg. Co. v. Linde Air Prod. Co., 336 *U. S.* 271, 277, 69 *S. Ct.* 535, 93 *L. Ed.* 672, 677–678 (1949), aff'd on rehearing, 339 *U. S.* 605, 70 *S. Ct.* 854, 94 *L. Ed.* 1097 (1950). In any event, the asserted tort claim grounded on an alleged misrepresentation depriving inventorship credit as to process and use, appears to be a relatively novel one in the law, and while we may be prepared to recognize such a claim where the circumstances justly call for it, we are not prepared to recognize it where, as here, the reliance is placed, not on any express misrepresentation of inventorship as to process and use, but on a supposed implication thereof from a patent claim which was carefully limited to the compound itself and was conceded throughout the trial to be invalid as such.

In *Mahn v. Harwood, supra*, the Court pointed out that in taking out a patent there must be a specific claim and that matters set forth in the specification but not embraced in the specific claim "are not claimed by the patentee, at least, not claimed in and by that patent"; in the course of his opinion for the Court, Justice Bradley had this to say:

> **"The public is notified and informed, by the most solemn act on the part of the patentee, that his claim to invention is for such and such an element or combination and for nothing more. Of course, what is not claimed is public property. The presumption is, and such is generally the fact, that what is not claimed was not invented by the patentee, but was known and used before he made his invention. But, whether so or not, his own act has made it public property, if it was not so before. The patent itself, as soon as it is issued, is the evidence of this. The public has the undoubted right to use and it is to be presumed does use, what is not specifically claimed in the patent." 112 *U. S.*, at *p.* 361, 5 *S. Ct.*, at *p.* 178, 28 *L. Ed.*, at *p.* 668**

In *Straussler v. United States*, 290 *F. 2d* 827 (*Ct. Cl.* 1961), the court referred to the distinction between the specification and the claim and stressed the great importance of the claim as describing for the world "the area of the invention beyond which no one may go without trespassing"; it pointed out that people naturally rely on the wording of claims and "are also entitled to rely on language deliberately excluded from the claims because this tends to indicate what

the inventor has agreed his invention is not." 290 *F. 2d*, at *p.* 831. Patent No. 2,878,263 fairly evidences on its face that no inventive claim was made on Oroshnik's behalf beyond the compound itself. Thus the opening paragraph states that the invention "relates to 4-methyl-4-phenyl-5-pyrazolone" and that "the novel compound" possesses particular value as an anticonvulsant and is useful in the treatment of epilepsy. Still later the statement is made that the object of the invention is to provide "a new compound" which has a high protective index and is nontoxic in use over a long period of time, and that another object of the invention is to provide "a new compound" for use in the treatment of epilepsy. The concluding portion explicitly states that "What is claimed is: The compound 4-methyl-4-phenyl-5-pyrazolone."

We have considered the many contentions made by the plaintiff in her briefs and at oral argument and have concluded that none of them warrants appellate disturbance of the trial court's dismissal of her action against some of the defendants and the jury's verdict in favor of the remaining defendants. Accordingly, the Appellate Division's decision insofar as it ordered a new trial as to the defendants Ortho, Oroshnik and Johnson & Johnson is:

Reversed and the judgment entered in the trial court in favor of all of the defendants is reinstated. No costs.

For reversal — Chief Justice WEINTRAUB, and Justices JACOBS, FRANCIS, PROCTOR, HALL and HANEMAN—6.

For affirmance—None.

APPENDIX C

Opinion of Superior Court of New Jersey, Appellate Division

(Filed March 11, 1964.)

NFORD, S.J.A.D.

Plaintiff, formerly employed by the defendant, Ortho armaceutical Corp., as a research chemist, brought this tion for damages by reason of Ortho's designation of a fferent person as "inventor" in its application for a tent which eventually was issued to it on a pharmaceuti- compound, the idea, manufacturing process and novel e of which was allegedly discovered by plaintiff. The avamen of the suit is that defendant's action thereby prived plaintiff of professional credit for the invention. he complaint and pretrial order also assert injury to aintiff's alleged property rights in the invention by proper and deficient preparation and prosecution of the tent application. Joined as defendants in the action re one Oroshnik, plaintiff's direct superior at Ortho, o was designated as inventor in the patent aforemen- ned, and certain other supervisory employees of the npany, as well as Ortho's parent corporation, Johnson Johnson, and its board chairman, Robert W. Johnson, o were charged to have participated in the alleged ongful acts through a Dr. Kell, patent attorney for nson & Johnson.

Defendants denied the allegations of the complaint, erted that Oroshnik, not plaintiff, invented the com- nd, and contended that plaintiff had assigned her prop- y rights in the patent to Ortho and that her asserted nt of credit was valueless in any event because the patent lf was invalid.

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The action was tried before a judge and jury in the Law Division. Plaintiff, not a lawyer, tried her case *pro se.* At the close of the plaintiff's case there was a dismissal by the court for lack of proof as to the defendants other than Oroshnik, Ortho and Johnson & Johnson. There is no demonstration of error on this appeal in that action, and it is herewith affirmed. The jury returned a verdict of no cause of action as to the defendants who remained in the case. Plaintiff's appeal advances numerous claims of error in rulings on proffered evidence, determinations of law during the proceedings, errors and deficiencies in the charge to the jury, and prejudicial conduct of the judge in trial of the case.

Preliminarily, note should be taken of the fact that plaintiff was unsuccessful in a prior action against the same defendants, claiming, *inter alia*, wrongful discharge from her employment with Ortho. We heretofore affirmed a judgment for defendants in that case, which was tried by a Law Division judge sitting without a jury, wherein it was held that the employment contract was at will, terminable by either party with or without cause. *Misani* v. *Ortho Pharmaceutical Corp.* (unreported, App. Div., May 18, 1962), certif. denied 38 N. J. 304 (1962).

Plaintiff, who is holder of a doctorate in organic chemistry, was employed by Ortho in January 1955 after she responded to an Ortho advertisement seeking an organic chemist to perform "research in synthetic medicinal chemistry" of "basic character." The following month she executed an agreement with Ortho providing in part as follows :

> "Fernanda Misani Fiordalisi
>
> (hereinafter called 'Employee'), in consideration of his employment, and of wages and salary paid, hereby assigns, and agrees to assign to

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(hereinafter called 'Company'), or its nominee, their successors or assigns, all his rights in inventions improvements and ideas which during the period of his employment, he has made or conceived or may make or conceive, either solely or jointly with others, in the course of his employment, or in the Company's time, or with the Company's material or facilities, or relating to any subject matter with which his work for the Company is or may be concerned, or relating to any business in which the Company or any of its subsidiary or affiliated companies is involved. . . ."

Plaintiff gave testimony at the trial of the following general import. Before joining Ortho she had had experience in the preparation and synthesizing of barbiturates, among other therapeutic compounds. Specifically, she had worked with 4-4 disubstituted pyrazolones (the substance of the compound in dispute) and she had a number of scientific patents and publications to her credit. About July 1955 she began to use her spare time at Ortho in research on a problem which had long defied organic chemists although considerable work had been done on it—the making of a substance which would contain the beneficial qualities of barbiturates but not their undesirable toxic and habituating characteristics. It is her contention in this case that she succeeded at Ortho in doing so, and that the patent issued to Ortho by the U. S. Patent Office on March 17, 1959 in the name of William Oroshnik as inventor (No. 2,878,263), claiming the compound, "4-methyl-4-phenyl-5-pyrazolone," resulted from her discovery of that compound and her invention of the process of making it, also disclosed in the patent but not claimed therein independently of the compound.

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Plaintiff testified that Oroshnik discouraged her efforts on the barbiturate project but she persisted. She offered in evidence notebook entries indicating preliminary unsuccessful experiments. On January 26, 1956, at a company seminar at which Oroshnik was present, as indicated by one of her working notebooks introduced in evidence, plaintiff disclosed the idea and the process for making the compound to those in attendance. Plaintiff explained in her testimony that the novelty of the process lay in the use of an acid in the final step of the production of an intermediate. She had made a search of the literature and testified it showed no "well known" process for making the intermediate at all.

Oroshnik, also a skilled research chemist, told quite a different story on the stand. He testified that at the time of plaintiff's employment at Ortho he was trying to create an anti-convulsant which would be an improvement over one then on the market. He stated that this field was one of his specialties. He directed plaintiff to salvage a common intermediate from an unsuccessful uracil project and combine it with hydrazine. She did this, and arrived at the yield of the pyrazolone compound which he was after—the subject matter of the patent. Although she worked out the details of the process, this was what he would expect of any senior chemist functioning under his direction and possessing basic chemical know-how.

Oroshnik also testified that some time after the termination of plaintiff's association with Ortho some 40 or 50 compounds, including that here in question, were sent to Dr. Kell, a Johnson & Johnson patent attorney and chemist who handled patent matters for Ortho as well. Oroshnik told Kell he conceived the idea for the pyrazolone compound and had directed plaintiff to make it, but he did not tell Kell he was the inventor of the compound or process.

Kell testified that Oroshnik told him these facts and that he, Kell, then concluded that Oroshnik was the inventor and arranged for the patenting of the compound.

A patent expert, McLean, testified on behalf of defendants that the patent was invalid because the formula of the compound was anticipated by a reference in Beilstein, a German chemical encyclopedia. He also undertook to refute plaintiff's position to the effect that if the patent claim on the compound was invalid the process of manufacture was nevertheless novel and patentable independently and that the patent claim could be validated also by amending it in the form of a claim for a method of treating convulsions by use of the compound. (We discuss the legal merits of these contentions *infra.*) McLean said the process of manufacture was neither novel or patentable, citing a number of supposedly supporting German publications which defendants offered in evidence (untranslated). McLean also gave the opinion that the suggested amendment of the patent claim as one for a proposed use for treatment of convulsions would not render it valid.

At the trial plaintiff also offered evidence of Ortho's attempt to secure a Canadian patent on the process as an admission against its position in this case, notwithstanding Ortho later withdrew it. She complains of the refusal of the trial judge to charge on the point. She also claims error in the court's refusal to allow in evidence a United States patent examiner's communication to her on a later application of her own to secure a patent on the process for the pyrazolone compound.

A previous interference proceeding brought in the United States patent office by plaintiff in relation to the Ortho patent based on her alleged priority in invention as against Oroshnik was dissolved by the agency on its own motion on the ground that the compound was not

patentable by reason of anticipation by the Beilstein reference and the effect of 35 U. S. C. §102, which precludes a patent where the invention has been patented or described in a printed publication in any country more than one year prior to the date of the application for patent in the United States.

I.

One of plaintiff's principal appellate contentions is that the trial judge erred in ruling, early in the case, that ownership of the invention or inventions here involved, as distinguished from any right of plaintiff to professional *credit* for them, vested in Ortho absolutely by virtue of the assignment agreement executed by plaintiff quoted above and that consequently the company was free to use or discard these discoveries or to patent them or scrap them, wholly or partly, at its unfettered will. We think the broad language of the contract, fairly construed, clearly requires this construction; compare *Vargas* v. *Esquire, Inc.*, 164 F. 2d 522 (7th Cir. 1947). Plaintiff contends, alternatively, that the assignment agreement is unenforceable as inequitable because the contract of hire was for no fixed term. Where, as here, an employee is engaged for purposes of research and invention, it is generally held that an assignment agreement by the employee of the tenor of that here involved will be upheld and enforced. *Patent & Licensing Corp.* v. *Olsen*, 188 F. 2d 522 (2d Cir. 1951); *Paley* v. *Dupont Rayon Co.*, 71 F. 2d 856 (7th Cir. 1934); Annot. 153 A. L. R. 983, 998 (1944). It makes no difference that the agreement of hiring is not for any fixed term. *Goodyear Tire & Rubber Co.* v. *Miller*, 22 F. 2d 353 (9th Cir. 1927), reversing the lower court decision relied upon by plaintiff reported in 14 F. 2d 776 (S. D. Cal. 1926). But see *Triumph Electric Co.* v. *Thullen*, 228 F. 762 (E. D. Pa.

1916), affirmed on a narrower ground in 235 F. 74 (3rd Cir. 1916).

Even apart from the express agreement of assignment, however, the invention became the property of Ortho as a matter of law as it is indubitable that "the inventor was engaged specifically to exercise [her] inventive faculties for the employer's benefit," and the specific idea and process here assertedly conceived by plaintiff was undeniably developed while at work for Ortho. *Kinkade* v. *N. Y. Shipbuilding Corp.*, 21 N. J. 362, 369 (1956); *International Pulverizing Corp.* v. *Kidwell*, 7 N. J. Super. 345 (Ch. Div. 1950); *Standard Parts Co.* v. *Peck*, 264 U. S. 52 (1924).

Plaintiff also argues that enforcement of the contract against her is improper because she was wrongfully discharged. But this contention is barred by the decision of the previous case against her on that point. The issue is *res judicata.*

Plaintiff's further contention that such enforcement of the contract violates the federal constitutional provision on patents is frivolous.

We consequently hold the view that the trial court was right in ruling that insofar as plaintiff's claim was postulated on the theory that she owned the inventions of the compound or process or the idea of patenting the use of the compound as an anti-convulsant it was groundless. She legally parted with that title anticipatorily when she took the job as a research chemist employed to make such discoveries and when she executed the assignment. Ortho owed her no duty to patent, or refrain from patenting these inventions or any aspect of them, or, if it did apply for patents, to do so properly or adequately, or to repair any deficiency in the patent issued, by amendment or otherwise.

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II.

Defendants have made no serious refutation of the proposition that if plaintiff did legally invent the compound and the process for making it she possessed a professional right of intellectual credit therefor even though she assigned "all [her] rights" in inventions, ideas, etc. to Ortho, and that a wrongful deprivation of that credit by publishing the formula and process in a patent as the invention of another would constitute an actionable tort. In the present case, the patent issued to Ortho in the name of Oroshnik as inventor, although claiming only the compound, also published the process and the idea of treating convulsions with the compound, thereby imputing all to his inventorship. But the trial court, although purporting to submit the issue of credit to the jury, expressed an opinion out of the presence of the jury that there was no such right, and we think it advisable that we lay the question to rest.

We are of the view that such an action lies, at least as respects patentable inventions or discoveries, and that plaintiff did not in any way surrender her rights in that regard.

It is of the essence of the patent law and public policy that a patent must be applied for in the name only of the true inventor, whether issued to him or to his assignee. 35 U. S. C. §102 (f); 69 C. J. S. Patents, §84, pp. 377, 378; *Kennedy* v. *Hazelton*, 128 U. S. 667, 672 (1888). The recognition of such a cause of action as is presently here under discussion obviously subserves the stated policy and tends to prevent an imposition upon the public.

Moreover, vindication of the claim to credit on the part of the aggrieved true inventor is readily assimilable to the principle of an action for interference with prospective economic advantage now thoroughly established in our law. *Mayflower Industries* v. *Thor Corp.*, 15 N. J. Super.

337 (Ch. Div. 1951), affirmed o.b. 9 N. J. 605 (1952). As succinctly summarized recently by the Chief Justice, "The law protects also a man's interest in reasonable expectations of economic advantage." *Harris* v. *Perl,* N. J. (decided February 3, 1964).

Notwithstanding the fact that the area of direct economic exploitation of the invention itself has by the relationship of the parties and their agreement been appropriated exclusively unto Ortho, nevertheless plaintiff, if the true inventor, retained the valuable right of accretion to her reputation as a research scientist in organic chemistry of credit for the invention if any patent should be issued and published in connection therewith. All contemplated advantages to the company from the plaintiff's assignment of inventions and ideas were fully and reasonably utilizable by it without the need to misrepresent the inventor on a patent application. It would be unreasonable and against public policy to construe the contractual assignment as a consent by plaintiff to an abrogation of her right of credit by means of the false attribution of inventorship in the published patent to another who was not the true inventor. Compare *Vargas* v. *Esquire, Inc., supra* (164 F. 2d 522), where an artist specifically assigned all rights to his pictures and to use of his name as artist.

General understanding of the foregoing assumptions by the business and scientific community is apparent.*

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* "* * * a United States patent is issued in the inventor's name, and although he assigns the rights to his company, his name will forever be attached to that patent. This is his indisputable claim to being an accomplished inventor, and *no one*—no company—can take this away from him. The more patents that bear his name, regardless of what he did with the rights to them, the greater is his standing in the technological community. Issued patents are tangible evidence of his worth as an inventor, and they are perfectly salable in his quest for a job wherever he goes." (emphasis by author). Barnes, "The Patent System From An Inventor's Point of View." 5 *Pat., T.M., and Copyright J.* 64, 68 (1961).

The rationale of plaintiff's cause of action may also be supported by the analogy of an action for slander of title, in that both rest upon publication by defendant of an untrue statement which has the effect of disputing plaintiff's rightful claim to ownership of something. See *Frega* v. *Northern New Jersey Mtg. Assn.*, 51 N. J. Super. 331, 337-338 (App. Div. 1958). The difference, however, is that in slander of title the protected interest is the vendibility of the subject matter of the title whereas credit for a patentable invention is not alienable.

III.

As indicated, defendants contended at the trial that assuming plaintiff had a right to *credit* as inventor of the compound, as distinguished from proprietorship of the invention itself, and assuming further that she rather than Oroshnik was the inventor, she sustained no damage (or less damage than otherwise) from any deprivation of that credit by defendants' actions since the patent was invalid because anticipated by the published Beilstein reference. Indeed, their argument predicated on this point was that there was no *substantial* claim to credit even involved in the case. We find that the statute cited above, 35 U. S. C. §102 (b), concludes the issue in respect of the narrow question of the validity of the patent claim to the compound itself. It provides that a patent is not issuable if "the invention was patented or described in a printed publication in this or a foreign country * * * more than one year prior to the date of the application for patent in the United States." The Beilstein reference was in fact published more than one year prior to Ortho's application for this patent. Plaintiff conceded at the trial that the patent on the compound *per se* was invalid.

To the limited extent indicated, therefore, defendants' position is correct, and their point with respect to damages and the substance of a claim, insofar as the value of the inventorship *credit* depends upon the validity of the patent claim to the compound itself, was well taken.

IV.

But plaintiff argues that inventorship of the basic idea, including the process and the use of the product as an anticonvulsant, was not determinable against her under the thesis that the claim for the compound *per se* was not patentable and that the patent as issued was invalid to that limited extent. She soundly argues that inventorship comprehends not alone the conception of a novel idea but reducing it to practice. *Application of Schlittler*, 234 F. 2d 882 (C. C. P. A. 1956). The Beilstein reference was merely to what plaintiff describes as a "type" formula. It did not reveal the properties, uses or the process for making the substance. As will be seen, *infra*, claims for a process of manufacture or for a new use of a known compound are patentable independently of the compound itself.

Although patentability of the basic invention in either of the respects last noted was stressed by plaintiff below and here primarily in terms of the effect of the trial court's rulings on the question of inventorship as between herself and Oroshnik and of defendant's asserted duty to perfect its patent, we find greater pertinence thereof in terms of the effect of such rulings on the jury's resolution of the issue of whether plaintiff had a cause of action at all independently of her contest *vis a vis* Oroshnik and of whether her claim was one of any value. For reasons to be stated, we find error in the trial court's handling of these issues, and that this requires a reversal and retrial, notwithstand-

ing some degree of imperfection in plaintiff's communication of her position on the points to the court. We so determine partly because the issues mentioned were recognized by the court and the parties and can be said to have been tried, and partly because the interests of a just resolution of this controversy so require.

The patent statute provides that an application for a patent must contain a specification incorporating "a written description of the invention, and of the manner and process of making and using it, * * *. The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." 35 U. S. C. §§111, 112. The patent protection is confined to the claim or claims stated which may be limited to the compound or apparatus, or to the process, or may claim both. *Continental Paper Bag Co.* v. *Eastern Paper Bag Co.*, 210 U. S. 405, 418-419 (1908); *Hall* v. *Keller*, 180 F. 2d 753 (5th Cir. 1950), cert. denied 340 U. S. 818 (1950). Notwithstanding the application describes both the compound and the process, the patent coverage is confined to what is expressly claimed as the invention.

By virtue of an amendment of the patent statute in 1952 patentable processes now include "a new use of a known process, machine, manufacture, composition of matter or material." 35 U. S. C. §100 (b). *Rohm & Haas Company* v. *Roberts Chemicals*, 245 F. 2d 693 (4th Cir. 1957). Previously, as noted by the court in *Rohm & Haas Company*, it was the "settled rule that a new use of an old product was not patentable." (245 F. 2d, at p. 698.) The former rule is illustrated by *In re Thuau*, 135 F. 2d 344 (C. C. P. A. 1943). That decision, relied upon by defendants here, is obviously no longer the law in view of the amendment of the statute and the illustration of its effect in *Rohm & Haas*

Company, supra. Matter of the Application of Walter L. Hack, 245 F. 2d 246 (C. C. P. A. 1957), cited by defendants as sustaining the old rule, cannot properly be understood as doing so in view of the acknowledgment therein of the unambiguous language of the statute as it now stands. The *Hack* case holds no more than that a patent sought in respect of a new use for an old product must be claimed in the form of a process claim, not a composition claim.*

The Ortho patent in the present case, as already seen, claimed only the compound. The patent, although not the claim, included a description of the process as well as a detailed statement of the scientific basis for the conclusion expressed therein that the "novel compound" claimed "possesses particular value as an anti-convulsant and is useful in the treatment of epilepsy." It is clear, therefore, as a matter of law, that plaintiff was *prima facie* right when she repeatedly contended below, as she does here, that the invalidation of the claim for the compound *per se* by the Beilstein reference would not have affected a claim either on the process of making the compound or the "process" of the new use of the presumably known compound as an anti-convulsant, had either or both of such claims been incorporated in the original patent or added

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* To illustrate the effect of the 1952 amendment, the court in *Rohm & Haas Company, supra*, sustained the validity of a 1953 reissue patent claim reading: "The process of controlling fungus growth on living plants which comprises applying to the plants a fungicidal composition having as an active ingredient a salt of an alkylene bisdithiocarbamic acid." The original patent, issued in 1943, was drafted as a claim identical with so much of the 1953 reissue claim as reads beginning with the words "a fungicidal composition," etc. The court indicated that there was some uncertainty as to the validity of the original patent as the composition was previously known, although not used for any practical purpose until the patentee conceived of its use as a fungicide. But the 1952 statutory amendment clearly validated the 1953 reissue patent as a claim for a new use even though of a known composition.

thereto by reissue. This assumes, of course, existence of the basic patent requirements of inventive novelty, utility and reduction to practice in such claims, and, so far as anything to the contrary may be deemed argued below or on this appeal by defendants, a jury issue as to satisfaction of such requirements was presented by the proofs.

The trial court early in the proceedings below, after ruling against plaintiff on her claim for property rights in the invention, expressly retained for trial the issue of improper representation by the patent of the *process* as the invention of Oroshnik rather than plaintiff, and stated in that regard that its patentability as "new, whether it was an invention" was relevant to the question of damages. Defendants sought to meet the issue by testimony of a patent law expert to the effect that any chemist conversant with the prior literature on the subject could have made the compound by the process plaintiff used and that it was therefore neither novel nor a patentable invention. Plaintiff testified that no one had made the specific compound—the "gem pyrazolone"—as distinguished from other pyrazolones, and that her use of an acid in the final stage of an intermediate was novel. This was not specifically controverted by defendants.

In relation to the patentability of the process plaintiff requested the court to charge the jury that: "A process is novel and patentable even if it is a combination of old elements, as long as the result is new and useful." So far as it went, this was a correct statement of the applicable law on the particular proposition thus enunciated, see *Respro* v. *Vulcan Proofing Co.*, 1 F. Supp. 45, 51-52 (E. D. N. Y. 1932); *Copease Mfg. Co.* v. *American Photocopy Equipment Co.*, 298 F. 2d 772, 781 (7th Cir. 1961). It was peculiarly relevant to the particular issue raised by defendants, and the general subject matter should therefore have

been incorporated in the charge when the court was dealing with the dispute as to patentability of the process. This is so even though, in the light of the testimony adduced by defendants, the requested charge would have had to be qualified to the extent that the combination should not be obvious to one having ordinary skill in the art, *Standard Brands* v. *National Grain Yeast Corp.*, 308 U. S. 34, 38 (1939). Nothing on this particular aspect of the law is to be found in the charge at all. See *State* v. *Abbott*, 36 N. J. 63, 68 (1961).

What the court did say to the jury anent the process was the following:

> "She makes some additional claims. She says that even if she did not invent the product or even if it was not patentable, which, of course, it was not, she invented the process, the means by which it was made. Her complaint is that the company got a patent on her product, that's what she is here for, complaining about, the company did not and Dr. Oroshnik did not and Dr. Kell did not and Johnson & Johnson did not get any patent upon the process, upon the means by which this thing was made. They didn't apply for a patent. She says they should have. She says they should have done so.
>
> She has no right to tell them that they must do it. They own it, whether she invented it or whether she didn't invent it, they own it. She did it on their time with their material and they can throw it out the window if they like, as far as she is concerned. • • •
>
> The only thing she is interested in is her name on the thing, if she has a right to that.
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> Mr. McLean testified as an expert that the process is not an invention. It is not new and there is nothing patentable in it. It is a part of the general

knowledge of chemistry available to everybody who studies the art. For this purpose he produced excerpts from chemical journals and other publications to show that all of the procedures described by Dr. Misani had been known before she used them.

Now, frankly, I don't see how you or I, as a practical matter, can decide on our own judgment whether he is right or whether he is wrong. I don't understand these publications, and some of them are in German, which makes it twice as hard. You tell me none of you read German. So I don't know what you are going to do with it. I suppose it comes down to this: You either have to believe Mr. McLean or you have to believe Dr. Misani. That is about what it comes down to, as far as that goes.

Of course, Dr. Misani, if she thought that Mr. McLean was wrong, could have produced an expert to contradict him. She did not do so, for whatever reason I do not know.

As far as that process is concerned, frankly, I don't see anything in it at all and I can't really see what claim she has." (emphasis added).

In the light of the pertinence of the issue of patentability of the process, as seen above, there are several prejudicially erroneous aspects of the foregoing comments. While the court was abstractly correct in telling the jury that plaintiff had no right to have the defendants patent the process insofar as any right of property on her part in the process was concerned, that subject was extraneous to the issues remaining on trial by the time of the charge as the court had earlier ruled out any property rights of the plaintiff in any aspect of the invention. A simple state-

ment to the jury that the court had so ruled would have sufficed. But since patentability of the process remained in the case in relation to the issue of damages (and, as defendants claimed in their summations, in relation to the gravamen of any claim for deprivation of credit at all; see *infra*), it was incumbent on the court to instruct the jury on the law relative to patentability of a process so that they might apply it to the disputed proofs and arrive at a properly considered conclusion. See, *e.g.*, *Keyes* v. *Grant*, 118 U. S. 25, 36 (1886); *cf. Philp* v. *Nock*, 84 U. S. 460, 462 (1873). Resolution of the issue was not a simple matter of whether to "believe" defendants' expert or the plaintiff. And the absence of guidance of the jury in this regard was compounded by the court's informing them that it saw nothing in the claim in relation to the process.

Moreover, the animadversion concerning plaintiff's failure to call an "expert" to refute McLean was, in our judgment, not fully warranted. While plaintiff's position as a party naturally affected her credibility (as, of course, did also Oroshnik's), yet the comment could have been prejudicial to plaintiff. The issue of patentability of the process involved mixed questions of fact and law. On the facts, including novelty, prior art and the basic chemistry involved, plaintiff, as an advanced expert in chemistry, was presumably at least as competent as McLean. On the law, the ultimate guide to the jury was or should have been the court, even assuming propriety of testimony by the patent-lawyer witness. See III *Walker, Patents* (1937) §747, p. 2052.

The availability of patent-law experts in cases directly or collaterally involving determinations of patentability does not minimize the function of the court in instructing a jury as to the law. The question of patentability is ulti-

mately one of law. *Great A. & P. Tea Co.* v. *Supermarket Equip. Corp.*, 340 U. S. 147, 155 (1950) (Douglas, J., concurring); *Bergman* v. *Aluminum Lock Shingle Corp. of America*, 251 F. 2d 801, 803 (9th Cir. 1957); *Armour & Co.* v. *Wilson & Co.*, 274 F. 2d 143, 151-157 (7th Cir. 1960). This is because patentability is a "constitutional standard," *Great A. & P., ubi cit., supra*, reduced to a problem of statutory construction as a result of the listing of the elements of that standard in 35 U. S. C. §§102, 103. *Armour & Co.* v. *Wilson & Co., supra* (274 F. 2d, at p. 156). Involved in the determination of patentability, however, is also, generally, the resolution of questions of fact, such as the state of the prior art, the nature of the inventor's discovery, and whether that discovery is novel or anticipated by the prior art. *Armour & Co., ubi cit., supra; Cee-Bee Chem. Co.* v. *Delco Chemicals*, 263 F. 2d 150, 153 (9th Cir. 1958); *Bergman* v. *Aluminum Lock Shingle Corp. of America, supra* 251 F. 2d, at pp. 809-810 (Pope, J., concurring). Those are peculiarly the appropriate pleas of testimony by patent experts. See *Winans* v. *The N. Y. & Erie R. Co.*, 21 How. (62 U. S.) 88, 100-101 (1859).

Helpful instructions to a jury in a case such as this, in relation to patentability of the process, would, therefore, be such as specifically required the jury to determine what had been accomplished and taught by the prior art, what if anything it was that plaintiff discovered with regard to the process, and the relationship of her discovery to such prior art. Ideally, the evidence in the case should have been brought by the court into focus as it reflected on the determination of those issues.*

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* Obviously, technical publications in a foreign language are useless to a jury. They should be submitted in English translation, if introduced as exhibits.

Our reversal in this case in relation to the matter of patentability of the process is not based, however, on the absence of an ideal charge on the law in this admittedly technical and complex area, but on the failure of the instructions to make such minimal exposition of the applicable law relevant to the issue, including the general subject matter of plaintiff's request, as would enable the jury properly to discharge its function other than by sheer reaction to the personalities of plaintiff and the opposing expert.

We next consider the failure of the trial court to charge the jury the law respecting patentability of the invention in respect of a novel use claim, particularly in the light of its frequent comments during the trial that amending the patent claim for that purpose was no concern of plaintiff. Agreed that insofar as plaintiff was claiming a duty to her by defendants to perfect the original patent claim, she was wrong. But insofar as the claim to deprivation of *credit* was concerned, patentability of a novel use claim had the same materiality to the issues as patentability of the process and of the compound. The use of the product for treatment of convulsions was plainly stated in the patent, and the representation of Oroshnik as inventor fairly extended to that feature of the disclosure as well as to the compound itself and the process. Defendants clearly recognized this aspect of the issues, as they were at pains to have their expert McLean testify that adding a use description to the claim would not validate it. McLean, however, relied on *In re Thuau, supra,* but we have seen that the effect of that decision was overcome by the 1952 amendment of the statute permitting process claims in the form of new uses of known compositions if framed as such. To the extent that defendants consistently contended that plaintiff's claim to credit was groundless and valueless

because there was no patent validity in her invention,* she had the right to attempt to show the contrary by proving that what was disclosed in the patent and attributed to the inventorship of Oroshnik contained patentable subject matter.

All that the trial court said to the jury in relation to the issue of patentability of the invention as a process or method claim for the new use of the compound as an anti-convulsant was this:

> "I have already mentioned the fact that Dr. Misani has repeatedly pressed the idea that Ortho could get a good patent if they changed the wording of the claim; and we have had evidence that they couldn't. Well, frankly, it doesn't make any difference whether they could or whether they couldn't. That is not what the suit is about. As I told you before, that's none of her business."

Not only did this constitute a failure to instruct the jury on the applicable law, but it took the issue of patentability of the alleged new use out of the case completely. And this notwithstanding defendants had recognized its materiality in relation to the value and gravamen of plain-

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* *E.g.*, after arguing that both the compound and process were known before plaintiff's work, one of defense counsel stated in summation: "What are we talking about in the first place. It just seems too clear * * * that there was nothing of credit or value which could have been taken from the plaintiff in this situation." The other counsel said: "You cannot be deprived of credit for something which has no value. Mr. McLean * * * says that Beilstein anticipated this compound * * *. Mr. McLean also said that the addition of the word 'anti-convulsant' adds nothing to it, you couldn't get a patent by using the word 'anti-convulsant.' " (rather an oversimplification of the nature of a process claim for a new use; see *Rohm & Haas Company* v. *Roberts Chemicals, supra*).

tiff's claim of deprivation of professional credit, as distinguished from a property right in the invention, and had offered testimony on the issue pointed to that aspect of the claim. This was error, and we regard it as clearly prejudicial to plaintiff.

One of plaintiff's requests to charge included a reference to remedying defects in the patent by additional claims for matter disclosed in the patent. In her exceptions to the charge she made substantially the same objection to the omissions in the charge in respect of this point as we have voiced. Although the request to charge was incomplete and formally defective and as such was properly refused by the court, it nevertheless was sufficient, in the background of the controversy as a whole and the importance of the specific point to a just resolution of the lawsuit, to have served to alert the court to the necessity of charging the jury on the law concerning patentability of claims for new uses of known compositions. Considering also the exceptions, it was error to fail to do so. See *State* v. *Abbott, supra* (36 N. J., at p. 68); *Grammas* v. *Colasurdo,* 48 N. J. Super. 543 (App. Div. 1958); *Cf. Kreis* v. *Owens,* 38 N. J. Super. 148 (App. Div. 1955).

Defendants urge that any deficiencies in the charge in either of the respects here found faulty are immaterial in that the verdict of the jury reflects they found Oroshnik rather than plaintiff to have been the inventor. This argument is premised on part of the court's charge as to damages. The court said, in part:

> "If, on the other hand, you should decide in favor of the plaintiff against any of the defendants, then you will have to decide how much.
>
> She claims two kinds of damages. She claims compensatory damages. She says, my reputation, my good name suffered because I didn't have the credit

for this that I did. She brings no proof of any special burden to her, any special loss of money. But in this type of case if indeed you were to find that she had suffered a diminution of her scientific reputation* through the wrongful acts of any of these defendants, you may allow her such reasonable sum as will compensate her for that loss of reputation.

Of course, you don't have much to go on in the case; there isn't much testimony. You just have to take the general picture and see what you come up with. If you can't find anything else, you *could* bring in nominal damages, just if you think she was right but she didn't get hurt. Why, *you could, I suppose,* bring in a dollar or something like that. Of course, you don't get to that question unless you find in her favor." (emphasis added).

The rule is that ordinarily a verdict of no cause of action may connote either no liability or no damages. *Kovacs* v. *Everett,* 37 N. J. Super. 133 (App. Div. 1955), certif. denied, 20 N. J. 466 (1956); *Carianni* v. *Schwenker,* 38 N. J. Super. 350, 356 (App. Div. 1955). A conclusion that the verdict here necessarily meant a finding of no inventorship by plaintiff *vis a vis* Oroshnik is not compelled by the trial court's instructions. These did not purport to make mandatory a return of nominal damages in the event of a determination of inventorship in plaintiff but no sub-

* It may be noted that the more appropriate emphasis as to plaintiff's claim of damage is that she was deprived of the accretion to her reputation as a chemical inventor which she would presumably have gained by the publication of a patent disclosing her inventions, here asserted to include compound, process, and new use.

stantial damages. Nominal damages was by clear inference left optional with the jury.*

But of even more importance, defendants emphasized throughout the case and particularly in summation, as already indicated that since plaintiff was not a first inventor of anything (even if she had priority as against Oroshnik) and thus had no patentable invention, her claim to credit lacked any real substance as well as value. Failure on the part of the jury because of absence of pertinent instructions in the charge to understand that the inventions disclosed in the patent could be patentable, and thus presumably valuable, with consequential value in the professional credit of inventorship therefore could readily have been a contributory factor in the determination of the jury to reject the claim of credit completely whatever they might have thought of the matter of priority as between plaintiff and Oroshnik *inter sese*. Supporting the likelihood of this is the emphasis in the charge of the invalidity of the patent as issued because of the Beilstein reference and the pervasive undertone in the charge as a whole of lack of merit in plaintiff's entire claim.**

Defendants have also argued that plaintiff cannot be deemed to have been damaged by any misrepresentation of her inventorship in the Ortho patent because she has since the trial of this action obtained a patent on the process. In the first place, the record before us does not include that fact. But even plaintiff's concession (indeed she dis-

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* The foregoing discussion, incidentally, points up the desirability in such a case as this of requesting a special verdict from the jury on the issue of the identity of the inventor (plaintiff made such a request below).

** In respect of which we do not mean to disparage the general right of a court to comment on the testimony. But see *Ridgewood v. Sreel Investment Corp.*, 28 N. J. 121, 128, 129 (1958).

closed this fact in her brief) that she now has the process patent will not eliminate the issue of deprivation of credit at the retrial. This is so for several reasons.

During at least the period between the issuance of the Ortho patent and that to plaintiff there was, if plaintiff was truly the inventor, a continuing tort of misrepresentation as to her inventorship. We cannot say that the presumptive damage then done her was necessarily erased automatically by the later patent to plaintiff. Further, the coexistence of both patents casts a substantial cloud on plaintiff's reputation as the true inventor. Ortho could have eliminated this by disclaiming its patent, 35 U. S. C. §252, or amending to show plaintiff as inventor, but it has chosen not to do either. Finally, since Ortho owns the process invention under the assignment from plaintiff, it can at any time and presumably will eventually exercise its rights and compel assignment of the process invention to itself. At that point there will be no impediment to its disclaimer thereof and consequent elimination of the asserted preservation of plaintiff's reputation as the inventor.

Defendants thus have not shown that the present existence of a patent in plaintiff's name negates damage to her.

We might at this point with an eye to the impending retrial state our concurrence in the trial court's instruction to the jury that they could allow plaintiff compensatory damages even though she could demonstrate no specific special damages. The problem is somewhat comparable to that of allowability of substantial (not punitive) damages in an action for libel *per se*. Moreover, the approach of the courts is liberal in relation to a wronged plaintiff where the very nature of the subject matter makes proof of specific damages difficult. Here, the loss from impaired

reputation for inventorship is highly correlative with the value of the patent. In the case of patented pharmaceutical products it ordinarily takes a long time to test and evaluate them and get government approval for their marketing. This should not preclude an award of reasonable damages for wrongful deprivation of credit in the interim. Compare the allowability of substantial damages on behalf of parents in an action for the wrongful death of a young child. *McStay* v. *Przychocki*, 7 N. J. 456 (1951). *Cf. Harris* v. *Perl, supra.*

Although the judgment is to be reversed for the reasons given above, some of the other grounds of appeal argued by plaintiff present questions which may arise again at the retrial and we will deal with them here to the extent deemed advisable.

V.

Plaintiff has contended that the question of the invalidity of the patent as issued was not properly triable for a number of reasons. First, it is argued that the issue was not comprehended by the pretrial order. However, we agree with defendants' ample showing that the issue was actually tried with plaintiff's acquiescence and without timely objection. R. R. 4:15-2. Miscellaneous other grounds for the argument have been examined and found without merit. An examination of the whole area of patentability of the invention in any aspect is fundamental to a just resolution of this controversy, as we have already seen, especially, as defendants argue, to the issue of damages, which was specified in the pretrial order. And insofar as plaintiff raises a number of procedural questions peculiar to federal patent practice and procedure in relation to patentability, we find them not appli-

cable or controlling in this collateral state-court inquiry. From the adjective standpoint, we are bound only by our own rules of practice and procedure. We do recognize that we are bound by federal substantive law as to patentability, and have so indicated above.

It seems desirable that in view of the outcome of this appeal and the contents of this opinion the case should be pretried anew before the retrial.

VI.

One set of plaintiff's objections to trial rulings appertains to the law of inventorship in respect of joint work of supervisory and subordinate employees, as here.

First, plaintiff contends that the testimony of Oroshnik on the issue of discovery should have been excluded because unsupported by corroborating evidence, citing *Radio Corporation of America* v. *Philco Corporation*, 201 F. Supp. 135, 149 (E. D. Pa. 1961); *Harper* v. *Zimmerman*, 41 F. 2d 261, 265 (D. Del. 1930). However, as defendants point out, those cases involved priority of conception and are inapplicable where, as here, each of two parties alleges that he conceived the basic idea and claims to have disclosed it to the other. In the circumstances, it would have placed an impossible burden upon Oroshnik to have required him to produce a corroborating witness on the question of his conception. That witness would have had to be the plaintiff for it was to her that he alleges he disclosed the discovery. "The question of invention as between . . . [the parties] is really one of veracity. . . . The evidence of one witness may be sufficient." *C. F. Mueller Co.* v. *Zeregas Sons*, 12 F. 2d 517, 518 (2nd Cir. 1926); *Concrete Mixing & Conveying Co.* v. *R. C. Storrie & Co.*, 27 F. 2d 838, 840 (9th Cir. 1928), aff'd 282 U. S. 175 (1930). Once

it is accepted, as was the tenor of defendants' proofs, that plaintiff was under the direction of Oroshnik in making the compound, then, as Kell testified, the entries of experiments in plaintiff's notebooks are corroborative of Oroshnik's claim to discovery.

Plaintiff also contends, in relation to her motion for judgment in respect of the process, that it should have been granted even if there were an open issue as to whether Oroshnik conceived the idea of the compound, since he admitted that he did not tell plaintiff what process to use in developing the compound. This argument, and the citation of *Pembroke* v. *Sulger*, 265 F. 996, 998 (Ct. App. D. C. 1920) and *Forgie* v. *Oil Well Supply Co.*, 58 F. 871, 876 (3rd Cir. 1893) in support thereof, are met by the circumstance that the cited cases dealt with situations where only the result to be accomplished was disclosed to the subordinate. Here, Oroshnik testified:

> "I assigned to Dr. Misani, therefore, I gave Dr. Misani a specific directive, since we were dropping the urecil project, to utilize whatever of the intermediate that she had accumulated, to condense that with hydrazine to give us the pyrazolones which would theoretically add to our anticonvulsant program."

This was more than simply telling plaintiff what result Oroshnik wanted. But the real issue here implicated is whether there was a jury question as to the existence of any element of novelty over the prior art in plaintiff's working out of the process. We hold defendants' proofs clearly did create such an issue for the jury.

Plaintiff makes a general attack on the portion of the charge dealing with the question of inventorship as arising between a superior and subordinate in an employment

relationship. The court's charge on this point consisted to a large extent of a quotation from 69 C. J. S., Patents §92 (a), (b), which we find basically supported by the authorities cited therein and need not discuss here. The charge adequately conveyed to the jury the concept that the supervisor can get help from a skilled subordinate in reducing his conception to practice and still be considered the inventor. The charge as given, moreover, was actually more favorable to plaintiff than it need have been. Basically, this was to the effect that where the idea of an invention is disclosed to an employee by the employer (or to a subordinate by a supervisor), there is a presumption that the final product arising from this collaboration is the invention of the employer. 69 C. J. S., Patents §92 (b), pp. 421-22. But in so instructing the jury the court was restricting the applicability of this presumption to the issue as to the good faith of Kell in deciding that Oroshnik was the inventor. Actually, the defendants were entitled to the benefit of the presumption on the factual question of who in reality (not merely in the mind of Kell) was the inventor. See *Riehm* v. *Hambleton*, 53 F. Supp. 328 (D. Mass. 1943).

Citing *Herrmann* v. *Otken*, 201 F. 2d 909 (C. C. P. A. 1953), plaintiff argues that there should have been no presumption in favor of Oroshnik in this case because her academic standing was equal to that of Oroshnik. But that decision merely explains that the background and experience of the contending claimants are factors to be taken into consideration in determining which party would be more likely to have conceived the invention. That proposition does not disparage the presumption that arises after it is shown (and believed) that the employer conceived the idea and instructed the employee in its development. Note here also that the trial court specifically charged that

there was no presumption if the jury did not believe that Oroshnik conceived the idea.

Plaintiff also argues that there was error in admitting Kell's testimony as to the statements made to him by Oroshnik on the ground that this testimony was hearsay. However, the testimony was not hearsay in the light of the limited use for which the trial court admitted it. The statements were not admitted to prove the truth of the matter asserted in them, *i.e.*, that Oroshnik conceived the idea, but solely in relation to the issue of Kell's good faith in arriving at the conclusion that Oroshnik was the inventor and in perfecting the patent applications. The truth of the statements was irrelevant for that purpose, the only question being whether or not they were made and whether or not Kell relied on them, as affecting the liability of Johnson & Johnson, his employer.

A similar analysis validates the court's instruction with respect to Kell's testimony that he would expect a research chemist to record conception of a novel idea in her notebook. That is what Kell said he expected, and it was one of the factors upon which he based his conclusion that Oroshnik was the inventor. The judge had excluded Kell's statement that the Ortho chemists were under instructions to make such entries, and his charge was consonant with that ruling. The fact of Kell's expectation of an entry was not admitted to show the existence of such instructions to chemists or that Oroshnik was in actuality the inventor. It went only to the reasonableness of the basis for Kell's conclusion on inventorship.